

REMARKS/ARGUMENTS

Reconsideration is respectfully requested.

The Office Action dated October 6, 2008 indicates that Claims 1-11 are presently being examined, Claims 12-20 being subject to a restriction requirement, and having been withdrawn from further consideration. The Restriction Requirement has been made FINAL.

The Office Action indicates that Claims 1, 2, 4, 6, 8, 10, and 11 are rejected under 35 U.S.C. §102(b) or (e) as being anticipated by U.S. Pat. Pub. No. 2003/0194658 ("Nishijima et al."), and Claims 5 and 9 are rejected under 35 U.S.C. §103(a) as being obvious over Nishijima et al. Claims 1, 2, 4, 5, 6 and 8 are separately rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. No. 6,908,726 ("Endo et al."), and Claim 5 is rejected under 35 U.S.C. §103(a) as being obvious over Endo et al. Claim 3 is rejected under 35 U.S.C. §103(a) as being obvious over Endo et al. in view of U.S. Pat. No. 5,589,324 ("Wexler"). Claim 7 is rejected under 35 U.S.C. §103(a) as being obvious over Endo et al. in view of U.S. Pat. No. 5,589,324 ("Wexler").

The Rejections Relying on Endo et al. are Improper Because Endo Is Not Prior Art

Applicants filed this application relying on a PCT application for priority, which itself relies on German Patent Application No. DE 10250408.3, filed on October 29, 2002. Applicants perfected the German application priority date by submitting a certified copy of the German application on March 17, 2005. Thus, Endo et al. fails to qualify as prior in time to the German application priority date, and cannot be considered a proper reference. Any rejection so relying on that reference thus is considered improper and withdrawal thereof is respectfully requested.

The Claimed Invention

The present invention provides a coating composition which is not a photographic composition but which enables to obtain an inscription in the interior of glass using a laser treatment of the glass surface. That is, the laser treatment causes local heating of the glass at a layer below the surface and enables silver ions (and optionally further, metal ions, as recited in Claims 2,3 and 22) to diffuse into the interior layers of the glass. After diffusing into the glass, the silver ions are reduced, either by Sn ions already present in the glass or by a reducing agent

also diffused into the glass. The composition disclosed and claimed in this application can be used in both cases, with or without a separate reducing agent as part of the composition.

The silver compound in the claimed composition is **not** photo-sensitive (none of the specific examples of suitable silver salts is photo-sensitive) and is not reduced by the laser irradiation (the laser treatment only serves to heat the glass so as to facilitate diffusion of the metal ions). A photo-sensitive compound is not suitable for the present composition since it would be reduced before diffusion and before entering the glass.

The Rejections Are Improper

The cited prior art, including Nishijima et al. (U.S. Pat. Pub. 2003/0194658), fail to show or disclose a silver containing solution that is first diffused into the inner layers of a glass before being reduced. This is because the reference '658 application, is drawn to and describes a silver salt photosensitive "photothermographic image material" for generating images at the surface of the paper or other substrate on which the photosensitive material is placed. Thus, any light that is placed on the material will reduce it before it has a chance to diffuse into the glass, as does the present silver material. Moreover,

The additional feature now recited in Claim 21 of "providing the capability of the silver ions to diffuse into the glass during the laser treatment and clusters of silver ions being reduced only upon diffusing into the glass . . ." is supported at page 3, lines 9-15 of the specification and is intended to recite that the silver compound of the present composition does not comprise a photo-sensitive silver halide, as do the cited references since such a photosensitive compound would be reduced before entering (diffusing into) the glass. The claimed feature recites that light-insensitive silver compound is capable of diffusing into the glass and to be reduced therein (in contrast to the light-insensitive organic silver salts of the cited references which remain on the surface of the support).

The Amendments to Claim 1, 11 and New Claim 21 Further Distinguishes the Cited References

Each of Claims 1, 11 and 21 as presently amended include the recitation that the silver salt or ion solution including the silver ions provides "the capability of the silver ions to diffuse into the glass during the laser treatment and clusters of silver ions being reduced only upon diffusing into the glass to thereby produce the desired image effect in the interior of the glass." None of the cited references shows discloses or even contemplates that diffusion of the silver

ions into the inner layers of the glass, after which they are reduced, thereby darkening or changing color to provide the desired image embedded in the glass.

The Dependent Claims 2-10, 12 and 22 are Separately Patentable

In particular, Claim 3 recites that the "additional metal compound" contains zirconium as a constituent metal. Although a zirconium compound may be taught in one or another reference, it should be pointed out that the cited references disclose the use of a zirconium compound for the purpose of increasing the hardness of the coating. In clear contradistinction, in the present invention the hardness of the coating is totally irrelevant and the zirconium compound is solely added to enhance the image-forming blackening effect (see page 4, second paragraph of the specification).

The Cited Prior Art Is Inapposite and Teaches Away from the Invention

With respect to Claim 9, Pollett et al. (U.S. Pat. No. 4,292,400) teaches in the way of a very general disclosure that tin (Sn) compounds may be used as reducing agents in photo-sensitive compositions. However, in US 2003/0194658 the specific organic reducing agent obviously is a very, if not the most, relevant feature of the composition disclosed therein and there is not any incentive for a skilled artisan to replace said reducing agent by a completely different kind of reducing agent which most likely will not provide an adequate performance.

For the above reasons, it is considered that the claims, as amended, find support in the application specification as filed, and that the combination of elements recited in the pending claims, as amended, distinguish over the references of record. Accordingly, reconsideration and withdrawal of the outstanding rejections are respectfully requested and an indication of allowable subject matter is earnestly solicited.

Respectfully submitted,



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